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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,752	07/01/2003	Olivier Cohu	ICH 296-US	5032

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,752

Applicant(s)

COHU, OLIVIER

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and response filed 23 Dec. 2005 is noted.
2. Claims 1-16 are now pending.

Response to Arguments

3. In view of applicant's amendment, the objections to claims 12 and 13 in the prior Office action are withdrawn.
4. With respect to the term "specific surface," while recitation of the term "specific surface area" would be clearer, the examiner determines that the units m^2/g are sufficient to convey that this is a surface area measurement. Consequently, the rejection under 35 USC 112, 2nd Para. in the prior Office action is withdrawn.
5. Applicant's arguments with respect to the art rejections have been fully considered but they are not persuasive.
6. With respect to claim 1, Kitamura teaches alumina, which is a metal oxide (see the rejection of claims 9, 10, and 12 at page 7 of the prior Office action). Consequently, this argument is not persuasive.
7. With respect to claim 6, applicant argues that the instant invention has a different reason for cooling down the coated support. This argument is not persuasive. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, applicant is reminded that, as long as some motivation or suggestion to combine the references is

Art Unit: 1762

provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See *In re Beattie*, 974 F.2d at 1312.

8. With respect to claim 11, applicant argues that, in the present invention, the “elements are incorporated into the crystal lattice and do not form a surface coating as taught by Inoue.” This assertion is unsubstantiated by any evidence of record and, more importantly, not recited in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. With respect to claim 14, applicant argues: “An electrically conductive layer which is taught by Applicant’s invention is not a conductive layer. A conductive layer contains ingredients which make the layer conductive whereas an electrically active layer has many more functional properties.” This assertion is unsubstantiated by any evidence of record. Further, none of the claims recite the “many more functional properties” of the layer. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Finally, applicant’s statement implies that these other functional properties are in addition to electrical conductivity.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. **Claims 1-5, 7-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitamura et al. (EP 1 120 281 A1).**

Art Unit: 1762

12. These claims are rejected for the same reasons set-forth under this heading in the prior Office action. As noted above, alumina is a metal oxide.

Claim Rejections - 35 USC § 103

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al., as applied to claim 1 above, further in view of Ashida et al. (JP 2001-096900 A).**

15. This claim is rejected for the same reasons as set-forth under this heading in the prior Office action.

16. **Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al., as applied to claim 8 above, further in view of Inoue et al. (US 6,620,508 B2).**

17. This claim is rejected for the same reasons as set-forth under this heading in the prior Office action.

18. **Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al., as applied to claim 12 above, further in view of Chapman et al. (US 6,841,609 B2).**

19. This claim is rejected for the same reasons as set-forth under this heading in the prior Office action.

20. **Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al., as applied to claim 1 above, further in view of Miyamoto et al. (JP 58-177390 A).**

21. This claim is rejected for the same reasons as set-forth under this heading in the prior Office action.

Allowable Subject Matter

Art Unit: 1762

22. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. The following is a statement of reasons for the indication of allowable subject matter: the reasons remain the same as set-forth under this heading in the prior Office action.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

25. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an

Art Unit: 1762

explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPF 3/2/2006

William Phillip Fletcher III
Patent Examiner, USPTO
Art Unit 1762



BRET CHEN
PRIMARY EXAMINER